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| 7590 Clarence A. Green Perman & Green, LLP, 425 Post Road Fairfield, CT 06430 | | | EXAMINER PAULA, CESAR B | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/041,081
Filing Date: January 07, 2002
Appellant(s): LEVINE, JONATHAN D.

Ralph D Gelling
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/14/2008 appealing from the Office action mailed 6/22/2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|-----------|---------|
| 6332149 | WARMUS | 12-2001 |
| 5655130 | DODGE | 8-1997 |
| 6413100 | DICKMEYER | 7-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, and 20 recite “*said digital structure and codes are devoid of said particulars to the needs of the originator*” *lim.(b)*. The Examiner could not find this limitation in the disclosure, described in a manner as to allow one of ordinary skill in the art to perform it. There is no mention of missing digital structure and codes particular to the needs of the originator. These are broad assertions not yet present in the disclosure of this invention. The citation of the specification (page 5, lines 11-12) discloses book files that are devoid of any particulars unique to the administrator of the system, not the originator.

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Claims 1-38 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *a universal format devoid of any particulars unique to the administrator of the system* (page 5, lines 11-12), does not reasonably provide enablement for “*said digital structure and codes are devoid of said particulars to the needs of the originator*” in *claims 1, and 20, lim.(b)*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Examiner could not find in the specification the universal format which is devoid of digital structure and codes particular to the needs of the originator. There is no mention of missing digital structure and codes particular to the needs of the originator or what this entails or encompasses on page 5 of the specification. These are broad assertions, which are not present in the disclosure of this invention.

Claims 1, and 20 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite “*said digital structure and codes are devoid of said particulars to the needs of the originator*” in *lim. b*. It is still unclear what is meant by the language, since the specification (page 5, lines 11-12) as indicated by the Applicant on page 8, discloses book files that are devoid of any particulars unique to the administrator of the system, not the originator. Therefore, it appears that the book would retain those characteristics specified by the originator regardless of what intermediate format the book might be converted into. Therefore, the book would not be *devoid of said particulars to the needs of the originator of said complete book file*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-22, and 28-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al, hereinafter Warmus (Pat.# 6,332,149 B1, 12/18/2001, filed on 2/11/1997), in view of Dodge et al, hereinafter Dodge (Pat. # 5,655,130, 8/5/1997).

Regarding independent claim 1, Warmus discloses the development of a template file representing pages of book(s) to be reproduced using data native to pc computer system, and using wordprocessing applications, such as Word®--*wherein said digital structure and codes includes particulars unique to the needs of the originator.* The file contains fixed, and variable information indicating customized information to be inserted into the file--*receiving as a complete book file digital, including a book block, a digital representation with a digital structure and codes of an originating software, hardware, and operating system of a book targeted for reproduction--* (col.7, lines 59-col.8, line 7, col.1, line 58-col.2, line 6, and col. 10, lines 45-67).

Moreover, Warmus discloses converting the stripped template file into a PDL or PDF file (device independent, does not depend on the computer platform on which it is displayed or

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printed), which can be transmitted to a different computer system or— *converting said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of said digital structure and codes of an originating software, hardware, and operating system* (col. 10, lines 45-67, col.7, lines 34-54, col.11, lines 1-10). The file contains information specifying the positioning of fixed information—*storing said solution-independent, intermediate formatted book file along with book identification information*(generic or independent format with information identifying fixed positioning) *as a mastered book*. Warmus fails to explicitly disclose *b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator*. However, Dodge teaches using a document to create another document containing various class of data elements. These data elements can then be filtered out to produce various platform-specific versions, such as UNIX, PC, etc., of the document(col. 4, lines 7-28, col.6, lines 20-67, fig.3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Warmus, and Dodge, for all the reasons found in Dodge, including increasing document delivery efficiency by producing a single document (instead of multiple document), which yields an appropriate platform-specific document based on the platform requesting the document.

Moreover, Warmus discloses premerging master PDL files with variable files before being provided to the printer —*converting said solution-independent, intermediate formatted book file to solution-dependent (premerged file) formatted book file* -- (col. 11, lines 47-51).

Furthermore, Warmus discloses using commands in a press file to create the finished books or book versions —*reproducing said book* -- (col. 11, lines 45-51).

Regarding claim 2, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced –*said book is in the form of electronic files* -- (col. 10, lines 45-67).

Regarding claim 3, which depends on claim 1, Warmus discloses scanning book pages into a system and printing them over a network –*scanning and converting scanned components into said digital representation* -- (col. 8, lines 8-30).

Regarding claim 9, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed –*generating hard copy book production information* -- (col.9, lines 12-44, col. 10, lines 45-67).

Regarding claim 10, which depends on claim 1, Warmus discloses using commands –*printing information* -- in a press file to create the finished books or book versions (col. 11, lines 45-51).

Regarding claim 11, which depends on claim 9, Warmus discloses creating the finished books or book versions in a “saddle-stitch” format –*binding information* -- (col. 9, lines 12-22).

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Regarding claim 12, which depends on claim 1, Warmus discloses using a RIP processor for converting the book page files into bitmap page files *--creating a bitmap of the book block --* (col. 8, lines 63-67).

Regarding claim 13, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files *--creating a bitmap of the book block --* (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B).

Regarding claim 14, which depends on claim 1, Warmus discloses the development of template files representing pages of books to be reproduced or printed *--generating hard copy book production information --* (col.9, lines 12-44, col. 10, lines 45-67).

Regarding claim 15, which depends on claim 1, Warmus discloses using a format, having watermarks and barcode—*security information--*, for the book pages to be printed (col. 29, lines 22-35, col. 30, lines 6-12).

Regarding claim 16, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a CRT or LCD display *--book presentation information comprises viewing capabilities --* (col. 7, lines 24-42).

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Regarding claim 17, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, page files into bitmap page files which are used to control a printer – *book presentation information comprises printing capabilities* -- (col. 7, lines 24-42).

Regarding claim 18, which depends on claim 1, Warmus discloses sending the book files to a remote location via the Internet –*providing access to said book via an electronic link* -- (col. 7, lines 34-52).

Regarding claim 19, which depends on claim 1, Warmus discloses sending the book files, via email, to a remote location via a computer network –*delivering said book to a predefined destination* -- (col. 7, lines 34-52).

Claim 20 is directed towards a computer system for implementing the steps found in claim 1, with the exception of a *book reproduction workflows*—which is taught by the method for producing books that includes several conversion and other production steps-- *book reproduction workflows* --, as taught by Warmus (col.10, lines 45-col.11, line50, and therefore is similarly rejected.

Claims 21-22, and 28-38 are directed towards a computer system for implementing the steps found in claims 2-3, 9-13, 9, 15-19 respectively, and therefore are similarly rejected.

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Claims 4-8, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Dodge, as applied to claim 1 above, further in view of Dickmeyer et al, hereinafter Dickmeyer (Pat. # 6,413,100 B1, 7/2/2002, filed on 8/8/2000).

Regarding claim 4, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book title*. However, Dickmeyer teaches providing the title of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 5, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book author*. However, Dickmeyer teaches providing the author of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and

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provide results targeted at specific areas the students are having problem (col. 3, lines 60-67).

This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 6, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publisher* However, Dickmeyer teaches providing the publisher of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 7, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the International Standard Book Number*. However, Dickmeyer teaches providing the ISBN of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Regarding claim 8, which depends on claim 1, Warmus discloses using a RIP processor for converting the book, which includes a cover, page files into bitmap page files (col. 8, lines 63-67, col.9, lines 45-61, fig.6A-B). Warmus fails to explicitly disclose: *said book identification information comprises the book publishing date*. However, Dickmeyer teaches providing the copyright date of a book allowing book object identification (col.5, lines 57-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Warmus, and Dickmeyer, because Dickmeyer teaches providing students online resources for searching and provide results targeted at specific areas the students are having problem (col. 3, lines 60-67). This allows the student to quickly and effectively retrieve data tailored to the student's needs.

Claims 23-27 are directed towards a computer system for implementing the steps found in claims 3-8 respectively, and therefore are similarly rejected.

(10) Response to Argument

The Appellant indicates that 'In particular the claims were amended in response to the rejection under 35 USC 112 and to support Applicant's arguments **distinguishing the newly cited reference Dodge**. These amendments were submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments were properly presented under 37USC1.116 and should have been entered in order to advance the prosecution of the application. In particular, Applicant amended independent claims i and 20 to further clarify what is meant by

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solution-independent intermediate format, devoid of said particulars unique to the "originating software, hardware, and Operating system". Applicant submits that this language removed the issues raised by the Examiner and were consistent with other claims and the specification. No new matter was presented. In addition claim 20 was amended to correct a word processing error discovered by Applicant. This error rendered the substance of the claim unclear and inhibited meaningful prosecution of the claim. Applicant's amendment to claim 20 should have been entered under 37 USC 1.116.' (pages 5-6). In this passage, the Appellant is arguing that the claim amendment should have been entered, because it not only corrected the 112 issues, but also distinguished over newly added Dodge. The amendment changed the scope of the claims, which necessitated a new search and/or consideration, and it did not simplify issues for appeal.

Moreover, the Appellant also remarks above that claim 20 was amended to correct a grammatical error. However, if one looks at the amendment to this claim, it is more than the mere correction of some minor informality. Almost the entire claim was amended to correct the wordprocessing error, which raises a lot of new issues after prosecution was closed, and did not simplify matters for appeal.

Further, the Appellant states that claims 1, and 20 are clearly described in the specification as to allow one of ordinary skill in the art to perform the step of converting to digital structure and codes are devoid of said particulars unique to the needs of the originator (pages 8-9). However, the Appellant failed to disclose which part of the specification reveals the

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removal of the particulars or what are the particulars being removed. Therefore, the 35 USC 112 rejections remain.

With respect to claim 20, the Appellant submits that "converting said complete book file to have a solution-independent, intermediate format, in a universal format wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator digital structure and codes of an originating software, hardware, and operating system."

This statement appears to be in conflict with the statement in the last paragraph on page 5 of the Office Action, it is assumed that the conflicting paragraph is an artifact of earlier office actions and was meant to be deleted." (page 10, parag.6-7). While it is true that the highlighted portions of the claim limitation was a remnant of previous claim, and left as an oversight, the combination of Warmus and Dodge discloses the pending claim limitation.

The Appellant also indicates that Warmus does not teach that the original structure includes particulars unique to the needs of the originator, because the original structure is irrelevant to the purpose of Warmus, and that the Examiner is merely trying to give the impression that Warmus solves a problem similar to the problem (page 10, last parag.). The Examiner disagrees, because the claim broadly states that the document is customized to include content 'particulars' unique to the originating user. We can see that Warmus teaches the creation of a document by a user using a word processing application, such as Wordperfect in a pc format. (col.1, lines 58-col.2, line 6, col.7, line 59-col.8, line 7). The data of the document contain content, formatting, styles, etc. chosen by or particular of the operating system, in this case pc.

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The Appellant argues that Warmus has no reference to changing digital structure and codes of an originating software, hardware and operating system (page 11, parag.4). While claim 1 recites: 'b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator;', the claim does not recite purported changing of the digital structure. Warmus does teach the *converting of a template file into a PDF file, which can be transmitted to a different computer system* (col.7, lines 31-54). It is noted that the features upon which applicant relies (as indicated above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, the Appellant indicates that Dodge does not teach the conversion of the master book file into a solution independent intermediate format (page 12, parag.2). Dodge discloses the partitioning of a document into elements, and defining/tagging the document elements with platform specific tags (col.4, lines 8-27). In other words, the document which was originally created having a first platform formatting (such as pc format), is redefined or converted to have elements in another platform (UNIX) format. Therefore, the second format being devoid of the particulars unique to the needs of the originator who created the document in the pc platform format.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For all of the reasons stated above the Examiner believes that the rejections should be sustained.

Respectfully submitted,

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| /CESAR B PAULA/ Primary Examiner, Art Unit 2178 |
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March 31, 2009

Stephen Hong, SPE 2178
SH(conf.)

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|---|
| /Stephen S. Hong/ Supervisory Patent Examiner, Art Unit 2178 |
|---|

William Bashore, SPE 2175
WB(conf.)

| |
|--|
| /William L. Bashore/ Supervisory Patent Examiner, Art Unit 2175 |
|--|